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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,018	08/27/2003	Hubert Kaffl	930008-2098.1	6469
20999	7590	10/11/2006	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			MIGGINS, MICHAEL C	
			ART UNIT	PAPER NUMBER

1772

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/650,018

Applicant(s)

KAFFL ET AL.

Examiner

Michael C. Miggins

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,6,7,10-13 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 6-7, 10-13, 15-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/30/06 has been entered.

## **REJECTIONS WITHDRAWN**

2. All of the 102 and 103 rejections set forth in the final rejection of 2/3/06, pages 3-8, paragraphs 4-9 are withdrawn.

## **REJECTIONS REPEATED**

3. There are no rejections repeated.

## **NEW REJECTIONS**

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 1772

5. Claims 1, 6, 10-11 and 21 are rejected under 35 U.S.C. 102(a) as being anticipated by Laux (WO 01/62489) and Laux (US 2003/0113492, cited only as the English translation of WO 01/62489).

Adhesive is the same as non adhesive.

Laux discloses a patch comprising a packaging surface element for adhesive goods or goods containing adhesive means, wherein the packaging surface element has a non-adhesive coating on its inner wall (see English abstract of WO 01/62489 and page 2, paragraphs [0016] – [0023]) of US 2003/0113492), wherein the non-adhesive coating is a sealable coating (since the coating can be a fluoroethylene which are sealable, page 2, paragraph [0023] of 2003/0113492), wherein the sealable material is a polyethylene (page 2, paragraph [0023] of 2003/0113492), wherein the non adhesive coating is based on a silicone (page 2, paragraph [0023] of 2003/0113492), wherein the non-adhesive is based on at least one halogenated hydrocarbon polymer (page 2, paragraph [0023] of 2003/0113492) (applies to instant claims 1, 7 and 10-11).

Laux does not directly disclose that the non-adhesive and sealable material are an admixture in the same layer. However, such a limitation is inherent in the disclosure of Laux because Laux discloses the packaging material is exposed to elevated temperatures (page 1, paragraph [0013]). At elevated temperatures at least some diffusion and mixing of the sealable layer and the silicone containing layer will take place thus resulting in an admixture consisting of the sealable layer material and the non-adhesive silicone material. Note that the claims do not indicate any concentrations for the sealable material and the non adhesive agent and thus diffusion mixing of even

Art Unit: 1772

molecules between the layers results in an admixture. Furthermore, applicant's very broad claims are not restricted to any particular number of layers.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laux (WO 01/62489) and Laux (US 2003/0113492, cited only as the English translation of WO 01/62489) in view of Ebbrecht et al. (US 5494979).

Laux fails to disclose the non-adhesive coating having a non-adhesive agent based on silicone or PDMS.

Ebbrecht discloses a non-adhesive coating having a non-adhesive agent based on silicone or PDMS (abstract, column 13, lines 42-62) for the purpose of providing improved non adhesiveness, or abhesiveness (applies to instant claims 1, 6-7 and 10-11).

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided the non-adhesive coating having a non-adhesive agent based on silicone or PDMS in the non adhesive coating of Laux in order to provide improved non adhesiveness, or abhesiveness as taught or suggested by Ebbrecht.

8. Claims 12-13 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanios (US 2001/0048987) in view of Laux (WO 01/62489) and Laux (US 2003/0113492, cited only as the English translation of WO 01/62489).

Kanios a packaged transdermal system wherein the system comprises a transdermal system comprising a support layer, a matrix and a covering layer, top and bottom (11 from Fig. 1) and is sealable (page 3, paragraphs [0034] – [0036]), wherein the matrix is selected from the group consisting of a self adhesive matrix and a matrix with an adhesive (page 2, paragraph [0029]) (applies to instant claims 12-13 and 15-16).

Kanios fails to disclose a sealable non adhesive coating having a non adhesive agent.

Laux discloses a patch comprising a packaging surface element for adhesive goods or goods containing adhesive means, wherein the packaging surface element has a non-adhesive coating on its inner wall (see English abstract of WO 01/62489 and page 2, paragraphs [0016] – [0023]) of US 2003/0113492), wherein the non-adhesive coating is a sealable coating (since the coating can be a fluoroethylene which are sealable, page 2, paragraph [0023] of 2003/0113492), wherein the sealable material is a polyethylene (page 2, paragraph [0023] of 2003/0113492), wherein the non adhesive coating is based on a silicone (page 2, paragraph [0023] of 2003/0113492), wherein the non-adhesive is based on at least one halogenated hydrocarbon polymer (page 2, paragraph [0023] of 2003/0113492) (applies to instant claims 12-13 and 15-16).

Art Unit: 1772

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided a sealable non adhesive coating in the system of Kanios in order to prevent the patch from sticking to the container as taught or suggested by Laux.

Laux does not directly disclose that the non-adhesive and sealable material are an admixture in the same layer. However, such a limitation is inherent in the disclosure of Laux because Laux discloses the packaging material is exposed to elevated temperatures (page 1, paragraph [0013]). At elevated temperatures at least some diffusion and mixing of the sealable layer and the silicone containing layer will take place thus resulting in an admixture consisting of the sealable layer material and the non-adhesive silicone material. Note that the claims do not indicate any concentrations for the sealable material and the non adhesive agent and thus diffusion mixing of even molecules between the layers results in an admixture. Furthermore, applicant's very broad claims are not restricted to any particular number of layers.

With regard to claim 15 it would have been obvious to have provided a folded pouch with only one end seam in order to provide ease of construction especially since layer 11 of Kanios is self sealable (page 3, paragraphs [0034] – [0036]).

9. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laux (WO 01/62489) and Laux (US 2003/0113492, cited only as the English translation of WO 01/62489) in view of Sprehe et al. (US 6361212).

Laux fails to disclose the use of pressure marks on the package surface element.

Sprehe discloses the use of marks on a polymeric substrate (Fig. 5, #3, column 3, lines 13-25). Sprehe discloses the use of marks (which broadly encompasses colored marks) for the purpose of providing marks or other machine readable indicia thereon the permit an electric eye or the like to read the marks and achieve proper registration and alignment of two portions of a bag (applies to instant claims 17-20).

It would have been obvious to one of ordinary skill in the art to combine Laux and Sprehe since each discloses sealed packages.

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided pressure marks on the package surface element in order to ensure proper registration of the package during sealing.

### **ANSWERS TO APPLICANT'S ARGUMENTS**

10. Applicant's arguments filed 6/30/06 have been carefully considered but are deemed unpersuasive.

Applicant has argued that none of the references disclose that the non-adhesive and sealable material are an admixture in the same layer. However, such a limitation is inherent in the disclosure of Laux because Laux discloses the packaging material is exposed to elevated temperatures (page 1, paragraph [0013]). At elevated temperatures at least some diffusion and mixing of the sealable layer and the silicone containing layer will take place thus resulting in an admixture consisting of the sealable layer material and the non-adhesive silicone material. Note that the claims do not indicate any concentrations for the sealable material and the non adhesive agent and



Art Unit: 1772

thus diffusion mixing of even molecules between the layers results in an admixture.

Furthermore, applicant's very broad claims are not restricted to any particular number of layers.

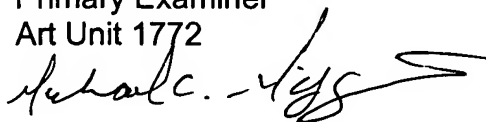
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is 571-272-1494. The examiner can normally be reached on 1:00-10:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael C. Miggins  
Primary Examiner  
Art Unit 1772



Application/Control Number: 10/650,018

Page 9

Art Unit: 1772

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September 5, 2006